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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,135	02/04/2000	John F. Stone	36435.0100	8366

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EXAMINER	
GOLDBERG, JEANINE ANNE	
ART UNIT	PAPER NUMBER
1655	17

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/498,135	STONE, JOHN F.	
	Examiner	Art Unit	
	Jeanine A Goldberg	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *April 30, 2001; Dec 12, 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☒ Interview Summary (PTO-413) Paper No(s). *9* .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

1. This action is a supplemental FINAL rejection since the amendment which was filed on April 30, 2001 crossed in the mail with the original FINAL rejection sent by the examiner on May 4, 2001. This rejection has been supplemented to be directed to the amendment which was filed inserting "having broken ends". Applicant's have not provided any new arguments in the after-final response filed on December 12, 2001.

2. The request filed on April 16, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/498,135 is acceptable and a CPA has been established. An action on the CPA follows.

3. This action is in response to the papers filed April 16, 2001 and April 30, 2001. Currently, claims 1-13, 15-17 are pending. All arguments have been thoroughly reviewed but are deemed non-persuasive for the reasons which follow. This action is made FINAL.

4. For applicant's convenience, the response to arguments from the advisory action of March 26, 2001 have been included in the instant action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 6-8, 11, 13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherry et al. (Mutation Research, Vol. 275, pg. 57-67, 1992) in view of Marcon et al (Mutation Research, Vol 45, pg 155-166, September 1999).

The claims have been amended to recite "chromosome fragments having broken ends" rather than "chromosome fragments". If a piece of nucleic acid is from a fragment of a chromosome, it would have a broken end. It is unclear how this recitation provides any limitations to the claimed invention. Further, marking at least some of the broken ends, rather than marking some of the chromosome fragments does not appear to provide any limitations to the claim.

Cherry et al. (herein referred to as Cherry) teaches facilitating disease diagnosis by exposing cells of a suspected diseased patient to a chromosome damaging agent which induce chromosome breakage and broken ends, marking some of the chromosome fragments, and analyzing the fragments to determine whether cells were affected by the disease. Specifically, peripheral blood lymphocytes from patients with Alzheimer's disease (AD) and controls were grown in culture for 72 hours with phytohemagglutinin (mitogen)(pg. 60, col. 2)(limitations of Claims 2 and 3). Then the cells were treated with bleomycin, which causes an activated oxygen radical, or with methyl methane sulfonate (MMS) (chromosome damaging agents)(abstract)(limitations of Claim 6-7, 13, 15). Then cells were harvested, fixed on slides, and marked with Giemsa stain (limitations of Claim 4). 50 cells/ patient were scored for chromosome damage. Comparison between patients with Alzheimer's and control patients was performed to determine whether a significant difference existed (limitations of Claims

14, 16 and 17). As seen in Figure 1, bar charts are presented which show significant differences between AD women and control women with bleomycin (pg. 62). Cherry teaches that when considering women, bleomycin is a very effective marker for AD (pg. 65, col. 1).

Cherry does not explicitly teach a method of diagnosing Alzheimer's using interphase cells.

However, Marcon et al. (herein referred to as Marcon) teaches a method of detecting chromosome damage and aneuploidy detected by interphase multicolour FISH in benzene-exposed shale oil workers. Marcon teaches the simultaneous detection of both chromosome breakage, involving damage-prone pericentromeric regions and hyperploidy in interphase cells (abstract). Marcon teaches that cultured lymphocytes of the benzene-exposed workers compared to the unexposed controls were modestly increased frequencies of breakage, suggesting an expression of premutagenic lesions during the S-phase in vitro (abstract). Myeloid leukemia-inducing agents include benzene (pg 164, col. 1). Macron also teaches that tandem labelling FISH can be usefully applied to human biomonitoring at interphase in different cell types (abstract). Macron teaches that the methodology was applied to interphase blood smear cells and culture lymphocytes, demonstrating the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2). Marcon teaches that "one advantage to the application of tandem labelling is the ability to detect chromosome changes in interphase nuclei, in addition to metaphase cells. As a result different cell types including those not amenable for metaphase analysis, can be

investigated" (pg 163, col. 2). Further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1).

Therefore, it would have been **prima facie** obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Cherry to predict the AD state of individuals with the method of Marcon for determining chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Cherry to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell.

Response to Arguments

The response traverses the rejection as filed March 14, 2001. The response asserts that Cherry does not teach analysis of the nucleic acid in interphase cells. The response asserts that Marcon does not discuss disease diagnosis. The response asserts that Marcon only teaches analysis of specific chromosomes in targeted areas. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of Cherry and Marcon would suggest disease diagnosis in interphase cells. As previously stated, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Cherry to predict the AD state of individuals with the method of Marcon for determining chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Cherry to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell.

The response asserts that the two references are nonanalogous and not combinable. In response to applicant's argument that Cherry and Marcon are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Cherry and Marcon are directed to analysis of

chromosome breakage. Cherry is directed to disease diagnosis based upon chromosome breakage wheras Marcon is directed to the interphase and metaphase analysis of chromosome breakage. The response asserts that nothing in either Cherry or Marcon teaches or suggest the combination of the two references. The ordinary artisan would have recognized at the time of filing that both interphase and metaphase cells may be analyzed for chromosome breakage, as taught by Marcon and Cherry respectively. The ordinary artisan would have also realized that disease diagnosis was facilitated by the analysis of chromosome breakage, as taught by Cherry. The ordinary artisan would have combined the teachings of Cherry, for diagnosis of AD by detection of chromosome breaks, with the teachings of Marcon that analysis of chromosome breaks in interphase cells had many added benefits, as provided above. There would have been a reasonable expectation of success that the ordinary artisan would have been able to induce chromosome damage in interphase cells for the purpose of disease diagnosis.

The response asserts that Marcon does not teach labeling the ends of chromosome fragments. This argument has been reviewed but is not convincing because the claims are not specifically directed to labeling ends of choromsome fragments.

The response suggests that Cherry nor Marcon disclose or suggest 3'-OH strands, however, Cherry specifically teaches that Bleomycin induces damage through the generation of activated oxygen and hydroxyl radical with the cell. In the case of bleomycin, these radicals tend to attach the C-5 position of the deoxyribose sugar ring

causing breakage of the ring and releas of the pyrimidine base. Thus, as pointed out in the Office Action mailed 12/14/00 on page 3, line 6, Cherry teaches producing 3'- OH strands (pg 64, col. 1).

6. Claims 1-2, 4, 11, 13, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (Mutation Research, Vol. 256, pg. 21-27, 1991) in view of Marcon et al (Mutation Research, Vol 45, pg 155-166, September 1999).

The claims have been amended to recite "chromosome fragments having broken ends" rather than "chromosome fragments". If a piece of nucleic acid is from a fragment of a chromosome, it would have a broken end. It is unclear how this recitation provides any limitations to the claimed invention. Further, marking at least some of the broken ends, rather than marking some of the chromosome fragments does not appear to provide any limitations to the claim.

Chen et al. (herein referred to as Chen) teaches facilitating disease diagnosis by exposing cells of a suspected diseased patient to a chromosome damaging agent, marking some of the chromosome fragments, and analyzing the fragments to determine whether cells were affected by the disease. Specifically, Chen teaches a sampling cells and transforming by Epstein-Barr virus to establish lymphoblastoid cell lines (pg. 22, col. 1). Cells were cultured in agar and subjected to irradiation (a chromosome damaging agent)(pg. 22, col. 2)(limitations of Claim 2). The colonies with 50 or more cells were isolated to determine the frequency of radiation-inducted aberrations. The cells were fixed, spread on slide, and stained with Giemsa to mark the chromosomes (pg. 22, col.

2)(limitations of Claim 4). Upon studying of the cells, a higher frequency of chromosome-type lesions was observed in AD cells, indicating the cells from AD patients were more radiosensitive than normal patients (pg. 25, col. 1). 12 or 14 patients show sensitivities greater than cells from age-matched controls (pg. 26, col. 1).

Chen does not explicitly teach a method of diagnosing Alzheimer's using interphase cells.

However, Marcon et al. (herein referred to as Marcon) teaches a method of detecting chromosome damage and aneuploidy detected by interphase multicolour FISH in benzene-exposed shale oil workers. Marcon teaches the simultaneous detection of both chromosome breakage, involving damage-prone pericentromeric regions and hyperploidy in interphase cells (abstract). Marcon teaches that cultured lymphocytes of the benzene-exposed workers compared to the unexposed controls were modestly increased frequencies of breakage, suggesting an expression of premutagenic lesions during the S-phase in vitro (abstract). Myeloid leukemia-inducing agents include benzene (pg 164, col. 1). Macron also teaches that tandem labelling FISH can be usefully applied to human biomonitoring at interphase in different cell types (abstract). Macron teaches that the methodology was applied to interphase blood smear cells and culture lymphocytes, demonstrating the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2). Marcon teaches that "one advantage to the application of tandem labelling is the ability to detect chromosome changes in interphase nuclei, in addition to metaphase cells. As a result different cell types including those not amenable for metaphase analysis, can be

investigated" (pg 163, col. 2). Further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1).

Therefore, it would have been **prima facie** obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Chen to predict the AD state of individuals with the method of Marcon for determining chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Chen to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell.

Response to Arguments

The response traverses the rejection as filed March 14, 2001. The response asserts that Chen does not teach analysis of the nucleic acid in interphase cells. The response asserts that Marcon does not discuss disease diagnosis. The response asserts that Marcon only teaches analysis of specific chromosomes in targeted areas. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of Chen and Marcon would suggest disease diagnosis in interphase cells. As previously stated, it would have been obvious to of ordinary skill in the art at the time the invention was made to have modified the method of Chen to predict the AD state of individuals with the method of Marcon for determining chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Chen to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell. The ordinary artisan would have realized that expanding the method of Chen to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell.

7. Claims 1-6, 11-13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parshad et al (PNAS, Vol. 93, pg. 5146-5150, May 1996) in view of Marcon et al (Mutation Research, Vol 45, pg 155-166, September 1999).

The claims have been amended to recite "chromosome fragments having broken ends" rather than "chromosome fragments". If a piece of nucleic acid is from a fragment of a chromosome, it would have a broken end. It is unclear how this recitation provides any limitations to the claimed invention. Further, marking at least some of the broken ends, rather than marking some of the chromosome fragments does not appear to provide any limitations to the claim.

Parshad et al. (herein referred to as Parshad) teaches a method for facilitating disease diagnosis by exposing cells of a suspected diseased patient to a chromosome damaging agent, marking some of the chromosome fragments, and analyzing the fragments to determine whether cells were affected by the disease. Specifically, Parshad teaches sampling skin fibroblasts and blood from patients diagnosed with Alzheimer's and control patients. The heparinized blood was mixed with phytohemagglutini (mitogen) and incubated for 48 or 68 hours (limitations of Claims 2 and 3). The lymphocyte cultures were subjected to either fluorescent light or 254 nm UV light (chromosome damaging agent that causes free radical-induced DNA damage) (pg. 5147, col. 1, para. 3 and 4)(limitations of Claim 6). Moreover, the cells were then treated with beta-cytosine arabinoside (araC) or caffeine (repair retarding agents) (limitations of Claim 5 and 12). Chromatid breaks were quantitated using cytogenetic analysis of metaphase cells.

Prashad does not explicitly teach a method of diagnosing Alzheimer's using interphase cells.

However, Marcon et al. (herein referred to as Marcon) teaches a method of detecting chromosome damage and aneuploidy detected by interphase multicolour FISH in benzene-exposed shale oil workers. Marcon teaches the simultaneous detection of both chromosome breakage, involving damage-prone pericentromeric regions and hyperploidy in interphase cells (abstract). Marcon teaches that cultured lymphocytes of the benzene-exposed workers compared to the unexposed controls were modestly increased frequencies of breakage, suggesting an expression of premutagenic lesions during the S-phase in vitro (abstract). Myeloid leukemia-inducing agents include benzene (pg 164, col. 1). Macron also teaches that tandem labelling FISH can be usefully applied to human biomonitoring at interphase in different cell types (abstract). Macron teaches that the methodology was applied to interphase blood smear cells and culture lymphocytes, demonstrating the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2). Marcon teaches that "one advantage to the application of tandem labelling is the ability to detect chromosome changes in interphase nuclei, in addition to metaphase cells. As a result different cell types including those not amenable for metaphase analysis, can be investigated" (pg 163, col. 2). Further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1).

Therefore, it would have been **prima facie** obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Prashad to predict the AD state of individuals with the method of Marcon for determining

chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Prashad to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell. Thus, based upon the teachings in Prashad that significant differences between AD and controls were observed when cells were treated with radiation and caffeine (pg. 5147, col. 2), the ordinary artisan would have been motivated to test unknown interphase samples to determine the AD status of the individual.

Response to Arguments

The response traverses the rejection as filed March 14, 2001. The response asserts that Prashad does not teach analysis of the nucleic acid in interphase cells. The response asserts that Marcon does not discuss disease diagnosis. The response asserts that Marcon only teaches analysis of specific chromosomes in targeted areas. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The

combination of Cherry and Marcon would suggest disease diagnosis in interphase cells. As previously stated, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Prashad to predict the AD state of individuals with the method of Marcon for determining chromosome damage in interphase cells. The ordinary artisan would have been motivated to have analyzed interphase cells using the method of Marcon for the expected benefits of the feasibility of using this approach to simultaneously investigate different cell types (pg 156, col. 2) including those different cell types including those not amenable for metaphase analysis, and further, "this allows cells with different metabolic capabilities and turn-over, or the same cell population in different phases of the cell cycle, to be studied" (pg 164, col. 1). The ordinary artisan would have realized that expanding the method of Prashad to include studying interphase cells as taught by Marcon would vastly increase the information gained with respect to the chromosome breakage in a cell. Thus, based upon the teachings in Prashad that significant differences between AD and controls were observed when cells were treated with radiation and caffeine (pg. 5147, col. 2), the ordinary artisan would have been motivated to test unknown interphase samples to determine the AD status of the individual.

The response suggests that Prashad nor Marcon disclose or suggest 3'-OH strands, however, Prashad teaches the lymphocyte cultures were subjected to either fluorescent light or 254 nm UV light (chromosome damaging agent that causes free radical-induced DNA damage) (pg. 5147, col. 1, para. 3 and 4)(limitations of Claim 6). Moreover, the cells were then treated with beta-cytosine arabinoside (araC) or caffeine

(repair retarding agents) (limitations of Claim 5 and 12). Thus, as pointed out in the Office Action mailed 12/14/00 on page 7-8, lines 1-3, Cherry teaches producing 3'- OH strands.

8. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherry et al. (Mutation Research, Vol. 275, pg. 57-67, 1992) in view of Marcon (Mutation Reserch, Vol 445, pg 155-166) as applied to Claims 1-4, 6-7, 11, 13-17 above, and further in view of Gorczyca et al (Cancer Research, Vol. 53, pg. 1945-1951, April 1993).

This rejection is applied to a narrower embodiment where Alzheimer's is detected using terminal deoxynucleotidyl transferase and nick translation assays.

Cherry does not specifically teach labeling the chromosome fragments with dNTP and exposing the fragments to a fluoresceinated material.

However, Gorczyca et al. (herein referred to as Gorczyca) teaches a method of detecting DNA strand breaks by in situ terminal deoxynucleotidyl transferase and nick translation. Gorczyca teaches sampling peripheral blood cells and culturing the cells (pg. 1945-1946)(limitations of Claim 2). After treatment the cells were subjected to in situ assays including the NT and TdT assay. For the NT assay, the cells were suspended with nick translation buffer, dATp, dGtp and dCTP and biotin-16-dUTP (pg. 1946, col. 1), the incubated with fluoresceinated avidin (limitations of Claim 8 and 9). For the TdT assay, fixed cells were suspended in a solution containing biotin-16-dUTP and dATP, dGTP and dCTP, this incubated with fluorescented avidin (limitations of

Claims 8 and 9). Gorczyca teaches that the advantages of TdT or NT assays include the direct labeling of 3'-OH termini of the DNA breaks (pg. 1950, col. 2)(Limitation of Claim 6). Further, image analysis or flow cytometry was performed to detect fluorescence emissions from each cell and the data was stored and analyzed (pg. 1946, col. 1)(limitations of Claim 10).

Therefore, it would have been **prima facie** obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Cherry in view of Marcon to include the labeling of the chromosomal fragments with biotin-16-dUTP and exposing to fluoresceinated avidin as taught by Gorczyca. The ordinary artisan would be motivated to have performed the method of Cherry in view of Marcon and labeled the fragments with biotin and fluoresceinated in order to allow rapid detection with flow cytometry and amenable to automation as taught by Gorczyca.

Response to Arguments

The response traverses the rejection as filed March 14, 2001. The response asserts that the teachings of Gorczyca with regard to apoptosis is not a disease state. This argument has been reviewed but is not convincing because the teachings of Gorczyca have not been used to demonstrate the diagnosis of a disease. The teachings of Gorczyca illustrate numerous means by which chromosome breaks may be analyzed. Apoptosis while not a disease state, per se, is involved in many disease states such as cancers. The chromsome breaks of the instant study, however, are a result of exposure to drugs. Regardless, Gorczyca specifically states that the response

of human leukemias to various drugs can be monitored with the TdT assay, implying that Gorczyca is indirectly diagnosis of disease state.

Thus for the reasons above and those already of record, the rejection is maintained.

Conclusion

9. No claims allowable over the art.

10. This is a CPA of applicant's earlier Application No. 09/498,135. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is

(703) 306-5817. The examiner can normally be reached Monday-Thursday from 7:00AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jeanine Goldberg
January 3, 2002

W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600